

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Edward James Rozhon et al.

Group Art Unit: 1651

Serial No.: 09/712,033

Examiner: Marx, Irene

Filed: November 14, 2000

Confirmation: 9130

For: Enteric Formulations of Proanthocyanidin Polymer Antidiarrheal Compositions

**REQUEST FOR RECONSIDERATION OF USPTO DECISION**

**REGARDING CORRECTION OF PATENT TERM ADJUSTMENT**

**UNDER 37 C.F.R. § 1.705(b)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This letter is to request reconsideration of the USPTO decision of February 6, 2008, which held in abeyance the previous request for correction of Patent Term Adjustment Under Rule 705(b), submitted on November 16, 2007. The reason for holding the decision in abeyance was that the patent had not issued, and the issue date would be required to make an accurate determination of the patent term adjustment, if any, to which the Patentee would be entitled. The patent for the application issued on March 11, 2008, as U.S. Patent 7,341,744. Therefore, Patentees respectfully request reconsideration of the previous USPTO decision.

For the convenience of the USPTO, the facts as set forth in the November 16, 2007 request are set forth again below, with updated information in view of a telephone interview with USPTO Senior Petitions Attorney Nancy Johnson on May 5, 2008. The \$200 fee required by Rule 18(e) was authorized in the original request of November 16, 2007, and according to the USPTO Decision of February 6, 2008, the fee does not need to be paid again for this request for reconsideration. This patent is not subject to a terminal disclaimer.

Pursuant to Rule 703(b), the Office is to grant a term adjustment for the number of days following three years from filing as follows:

(b) The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

(1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued;

(2) (i) The number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension;

(3) (i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 41.39 of this title in the application under secrecy order and ending on the date the secrecy order was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) of this chapter and ending on the date of mailing of the notice of allowance under 35 U.S.C. 151; and,

(4) The number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

### **Telephone Interview Summary**

The undersigned thanks Nancy Johnson, Senior Petitions Attorney, Office of Petitions, for the courtesy of a telephone interview on May 5, 2008, and for her assistance in showing the undersigned how the USPTO calculated the 453 day Patent Term Adjustment, as discussed below.

### **Calculation of Periods for Patent Term Adjustment**

#### Under Rule 703(b)

Patentees previously arrived at a calculation of 784 days of USPTO delay under 703(b), as discussed in the request for Patent Term Adjustment dated November 16, 2007.<sup>1</sup>

However, the USPTO arrived at a calculation of 1048 days of USPTO delay under 703(b), which is the period from November 14, 2003 (36 months from the filing date of November 14, 2000) until the first RCE was filed on September 27, 2006.

#### Under Rule 703(a)

The USPTO has determined that the USPTO incurred 554 days delay under 703(a) for the period beginning 14 months from filing (i.e., January 14, 2002) until the mailing of a

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<sup>1</sup> As set forth in the Request dated November 16, 2007, the application was filed on November 14, 2000, and the period exceeding 36 months begins November 14, 2003. A first Notice of Appeal was mailed on January 28, 2005. The period from November 14, 2003 to January 28, 2005 is 441 days. A non-final Office action was mailed on March 21, 2005, restarting the period under Rule 703(b). A second Notice of Appeal was mailed on February 26, 2006, followed by an RCE which was filed September 27, 2006. The period between March 21, 2005 (restart) and February 26, 2006 (2<sup>nd</sup> Notice of Appeal) is 343 days. Thus, Patentees calculated that the total period of USPTO delay under Rule 703(b) is 784 days (441 days plus 343 days).

Restriction Requirement on July 22, 2003. The USPTO also found that the USPTO incurred 19 days delay under 703(a) for the period beginning 4 months from filing of an Amendment After Final Rejection until the mailing of a Non-Final Rejection (i.e., the period from March 2, 2005 to March 21, 2005).

#### Reduction Under Rule 704

Patentees do not dispute the USPTO determination of 595 days of Patentee delay.

#### Period of Patent Term Adjustment

The period for patent term adjustment should be the sum of non-overlapping days under Rules 703(a) and 703(b) minus the days of Patentee delay. In the papers filed on November 16, 2007, Patentees requested a patent term adjustment of either 189 or 743 days.

The USPTO has previously indicated that its policy is to view Rule 703(a) delays occurring before three years from filing as overlapping with Rule 703(b) delays occurring after three years from filing. See Federal Register, vol. 69, no. 118, page 34384, footnote 5, June 21, 2004. As such, according to the USPTO, both the 554 days under 703(a) and the 19 days under 703(a) are overlapping with the 1048 days under 703(b). Therefore, the USPTO calculated a patent term adjustment of  $1048 - 595 = 453$  days.

However, the plain reading of the statute does not permit the USPTO to excuse one delay simply because they caused another delay. Patentees believe that in this case the 554 days of delay under Rule 703(a) are non-overlapping with the days of delay under 703(b). In other words, the USPTO delay from January 14, 2002 until July 22, 2003 (delay under Rule 703(a)) does not overlap with the USPTO-calculated delay from November 14, 2003 until September 27, 2006. Therefore, Patentees are entitled to the sum of all the non-overlapping delays minus the days of Patentee delay, yielding a calculation of  $(1048 \text{ days} + 554 \text{ days}) - 595 \text{ days} = 1007 \text{ days}$ .

Alternatively, using the Patentees original calculation under Rule 703(b) in the papers filed November 16, 2007, Patentees are entitled to the sum of  $(784 \text{ days} + 554 \text{ days}) - 595 = 743$  days.

Summary of Requested Correction to PTA

The patent term adjustment printed on the face of U.S. Patent 7,341,744, is **453 days**, which differs from the patent term adjustment as calculated by Patentees in the papers filed November 16, 2007. The patent term adjustment of 453 days according to the face of the patent is incorrect because it improperly interprets the plain language of the statute. Patentees request that the patent term adjustment be adjusted upward to either **1007 days**<sup>2</sup> or **743 days**<sup>3</sup> on the basis of non-overlapping periods for USPTO delay under Rules 703(a) and (b).

**AUTHORIZATION**

The Commissioner is hereby authorized to charge the fee set forth in 37 C.F.R. § 1.18(e) to Deposit Account No. **50-3732**, Order No. 13784.105005. The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this communication to Deposit Account No. **50-3732**, Order No. 13784.105005. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **50-3732**, Order No. 13784.105005.

Respectfully submitted,  
King & Spalding, LLP

Dated: May 6, 2008

By: /michael willis/  
Margaret B. Brivanlou / Michael A. Willis  
Reg. No. 40,922 / Reg. No. 53,913

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<sup>2</sup> based on the USPTO's calculation of 1048 days of 703(b) delay

<sup>3</sup> based on the Patentee's calculation of 784 days of 703(b) delay



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**FEB 06 2008**

**OFFICE OF PETITIONS**

In re Application of	:	
Rozhon et al.	:	
Application No. 09/712,033	:	ON APPLICATION
Filed: November 14, 2000	:	FOR
Atty Docket No. 13784.105005	:	PATENT TERM ADJUSTMENT

This is in response to the REQUEST FOR CORRECTION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) filed November 16, 2007<sup>1</sup>. Applicants assert that the initial determination of patent term adjustment mailed November 7, 2007 omits the period of adjustment under Rule 703(b).

The instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date. A decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is ordinarily required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Moreover, even where as here a request for continued examination (RCE) has been filed, it is appropriate to hold a decision in abeyance. The RCE cuts-off the applicants' ability to accumulate any additional patent term adjustment against the three-year pendency provision, but does not otherwise affect patent term adjustment. Nonetheless, the calculation of the period of adjustment under Rule 703(b) occurs with knowledge of

<sup>1</sup> This application was timely filed with payment of the Issue Fee on November 16, 2007.

the actual date the patent is to be issued. Furthermore, this calculation is not reflected in the initial determination mailed with the notice of allowance, but rather is reflected in the revised patent term adjustment indicated in the patent. Accordingly, it is appropriate to render any decision on this issue after issuance of the patent and with respect to the revised patent term adjustment indicated in the patent.

Applicants are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read 'Nancy Johnson', written over the printed name.

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions